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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,528	07/17/2003	Jagdip N. Thaker	03122	2483

7590 08/22/2005

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EXAMINER
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NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/621,528

Applicant(s)

THAKER, JAGDIP N.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a process for producing microspheres, classified in class 524, subclass 425.
- II. Claims 16 and 17, drawn to a process for producing microspheres, classified in class 526, subclass 227.
- III. Claims 18-20, drawn to microspheres and color toners, classified in class 430, subclass 110.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I or II and invention III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as a process comprising the steps of: (1) dissolving or dispersing a styrene-acrylate polymer resin in an organic solvent to form a solution; (2) treating a micronized wax, a pigment, and a charge control agent with a coupling agent; (3) dispersing the treated

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composition of step (2) in the solution of step (1) to form an oily mixture; (4) dispersing the oily mixture in an aqueous solution to form dispersed particles; (5) removing the organic solvent to form spherical toner particles; and (6) washing and drying the spherical toner particles. Such a process does not require the steps for polymerizing co-monomers in a second vessel with a polymerization initiator as required in the method of Invention I or in the method of Invention II.

Furthermore, the method as claimed in Invention II can be used to make other and materially different product, such as colorless microspheres used as polymeric fillers. Such a product does not require the presence of a pigment, a micronized wax, or a charge control agent as required in the product of Invention III.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. Invention I is drawn to a method of making colored polymerized microspheres that comprise a pigment, a micronized wax, and a charge control agent, each of which is treated with a coupling agent. Invention II is drawn

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to method of making colorless polymerized microspheres that comprise a copolymer. In addition, the claims in Invention II do not require the steps of treating a charge control agent, a pigment, and a micronized wax with a coupling agent, or the step of charging the treated charge control agent, pigment, and micronized wax to a second vessel as required in the method of Invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and as shown by their different classification, restriction for examination purposes as indicated is proper.

3. If applicant elects the invention of Group I, claims 1-15, he must also respond to the following election of species requirement regarding those claims.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Distinct processes that use the following distinct components.

(1) A distinct dispersion stabilizer as recited in instant claims 2 and 3;

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(2) Distinct co-monomers as recited in instant claims 4 and 5;

(3) A distinct charge control agent as recited in instant claims 6 and 7;

(4) A distinct pigment as recited in instant claim 8.

(5) A distinct polymerization initiator as recited in instant claim 9; and

(6) A distinct coupling agent as recited in instant claims 11-13.

Applicants are required to elect an ultimate species of invention, wherein the following components used in the process are identified as unique chemical compounds or compositions:

(1) the dispersion stabilizer is identified as a unique chemical compound, for example, tricalcium phosphate as recited in instant claim 3;

(2) the co-monomers are identified as unique chemical compounds, for example, styrene and n-butylacrylate as recited in instant claim 5;

(3) the charge control agent is identified as a unique chemical compound, for example, the compound or compounds sold in association with the trademark BONTRON E-84 as recited in instant claim 7;

(4) the pigment is identified as a unique chemical

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compound, for example, carbon black as recited in instant claim 8;

(5) the polymerization initiator is identified as a unique chemical compound, for example, benzoyl peroxide as recited in instant claim 9; and

(6) the coupling agent is identified as a unique chemical compound, for example, neopentyl(diallyl)oxytri(dioctyl)pyrophosphate titanate as recited in instant claim 13.

Applicant should identify all claims that read on the ultimate elected species of invention comprising the uniquely identified components (1) to (6).

Applicant are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-15 are generic.

Applicant are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be

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entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. If applicant elects the invention of Group II, claims 16 and 17, he must also respond to the following election of species requirement regarding those claims.

Claims 16 and 17 are generic to a plurality of disclosed patentably distinct species comprising distinct processes using the following distinct components:

(1) A distinct dispersion stabilizer - see the instant specification, page 10, lines 4-15;



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(2) Distinct co-monomers, where the instant specification defines the term "co-monomer" as referring to two monomers selected from the Markush group disclosed at page 6, line 11, to page 7, line 9, of the instant specification; and

(3) A distinct polymerization initiator - see the instant specification at page 9, line 19, to page 10, line 1.

Applicant is required to elect an ultimate species of invention, wherein the following components are identified as unique chemical compounds or compositions:

(1) the dispersion stabilizer is identified as a unique chemical compound;

(2) the co-monomers are identified as a unique chemical compounds; and

(3) the polymerization initiator is identified as a unique chemical compound.

See, for the example, the process for making colorless microspheres in example 6 at pages 14-15.

Applicants should identify all claims that read on the ultimate elected species of invention comprising the uniquely identified process.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Should applicants traverse on the ground that the

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species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Due to the complexity of the restriction requirement, the election of species requirements, and the further requirement of the identification of the ultimate species of invention, applicant's representative was not contacted to request an oral election to the above restriction requirement.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention, and if either Inventions I or II is elected, an election of the ultimate species of invention, to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD  
Aug. 16, 2005

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1600  
1700